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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/804,538 | 03/19/2004 | Carroll H. Morgan | 30138-02 | 7493 |

7590

05/19/2005

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| EXAMINER |
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LE, THIEN MINH

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| ART UNIT | PAPER NUMBER |
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2876

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/804,538 | Applicant(s) MORGAN, CARROLL H. | |
| | Examiner Thien M. Le | Art Unit 2876 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

The information disclosure statement filed on 3/19/2004 has been entered.

Claims 1-20 are presented for examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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Claims 1-4, 6, 8, 9, 11, drawn to the apparatus and method and process claims 13-15, 17, and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Turner (Turner – 5,101,970).

Turner discloses “a system for in-home collection and preservation of information for identifying and locating lost or missing loved ones. The system includes devices for collecting, sealing, and preserving hair, blood, and fingerprint samples from each loved one and for recording vital person data regarding each loved one. The information and samples are collected, sealed and stored in the family freezer to insure that the collected specimens remain viable indica of identification for long subsequent periods of time.” (Abstract).

Figure 1 of Turner shows a sealable plastic envelope 17 adapted to receive the hair sample and to receive a card 18 bearing the date of the sample and the identity of the person from whom the sample was taken.

Regarding claim 1, 8 and 13, Turner discloses an envelope 17 which serves as the claimed clear laminate envelop; a card for identifying a person (figure 1); a hair sample (figure 1); and thus would embrace all limitations set forth in these claims.

Regarding claims 2, 9 and 15, see the discussions regarding claim 1. Further, Turner discloses the method and means for collecting, sealing and preserving hair, blood, fingerprint samples, etc. from a person (abstract & specification) which thus would embrace all limitations set forth in these claims.

Regarding claims 3, 17, and 20, see the discussions regarding claim 1. Further, the claimed limitations "cut at a predetermined end" is considered subjective in that a person can choose to cut the envelope in order to obtain the collected samples.

Regarding claims 4, 11 and 14, in addition to the envelopes for collecting DNA samples, Turner also discloses that "printed on the side of card 23 opposite the fingerprint matrix is a form for recording vital personal data regarding the individual whose identity is being secured. This form includes positions for recording the image of the individual through a photograph as well as other vital data such as name, address, place of birth, date of birth, hair color, eye color, etc. Such data can be and often is valuable in identifying persons who are alive but who may have lost their memories, grown older or disguised their identity." Thus, Turner discloses all limitations set forth in these claims.

Regarding claim 6, see the discussions regarding claim 1 and figure 1.

Regarding claim 19, see the discussions regarding claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7, 10, drawn to the apparatus and method claim 16, are rejected under 35 U.S.C. 103(a) as being unpatentable over Turner (Turner – 5,101,970).

Regarding claims 7, 10 and 16, see the discussions regarding claim 1. The claim differs in calling for the step of calling saliva of a person instead of other DNA sources disclosed by Turner such as blood, skin tissues, hair, etc. However, it would have been obvious to use Turner's system to collect saliva of a person. The modification allows a person to use Turner's teachings of the plastic envelopes to collect saliva as an alternative DNA source.

Claims 5, 12, drawn to the apparatus and method claim 18, are rejected under 35 U.S.C. 103(a) as being unpatentable over Turner (Turner – 5,101,970) in view of JP Patent No. 11-216969 (JP No. 11-216969; YOCHN, 10/8/1999; herein after referred to as “Yochn”).

Regarding claims 5, 12, 18, see the discussions above regarding claims 1, 9, and 13 respectively.

The claims differ in calling for the step of writing medical information or instructions in different languages.

However, this claimed limitation is not new. Reference to Yochn is cited as evidence showing the conventionality of the method of printing medical information and/or instructions in multiple languages. Specifically, Yochn shows in figures 1-3 a medical card comprising information printed in multiple languages.

It would have been obvious to print information in multiple languages in the manner as suggested by Yochn in the system as taught by Turner. The modification allows foreign personnel to access medical information when the owner of such information/data is on travel, etc.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien M. Le whose telephone number is (571) 272-2396. The examiner can normally be reached on Monday - Friday from 7:30am - 4:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Le, Thien Minh
Primary Examiner
Art Unit 2876
May 10, 2005